

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Atty. Docket No.:	004770.00042
Mikko Makipaa et al.		
Serial No.:	Group Art Unit:	2173
Filed: March 7, 2002	Examiner:	Dennis G. Bonshock
For: Creating A Screen Saver From Downloadable Application On Mobile Devices	Confirmation No.:	9273

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply to the Examiner's Answer mailed October 15, 2008.

The Examiner's Answer presents no substantive reasons for upholding the claim rejections. Not only is the Answer composed of flawed, internally inconsistent reasoning, the Examiner's justification for upholding the rejection has changed since the final Office Action. The Examiner has presented a moving target as to how the various cited references are supposed to relate to one another and to the claimed invention. In any case, however the references are applied, the cited art does not reach the claimed invention under Section 103. The rejection is improper and must be reversed.

As discussed in more detail in the opening brief, the claims specify a *carousel*. With reference to claim 8, for instance, the carousel comprises a database that is stored in a storage medium. The carousel contains a handle for an application, and rules for selecting the application handle. The database further contains application execution parameters associated with the handle. As the specification provides, the rules "generally determine when each handle is executed in the screen saver mode" (p. 3).

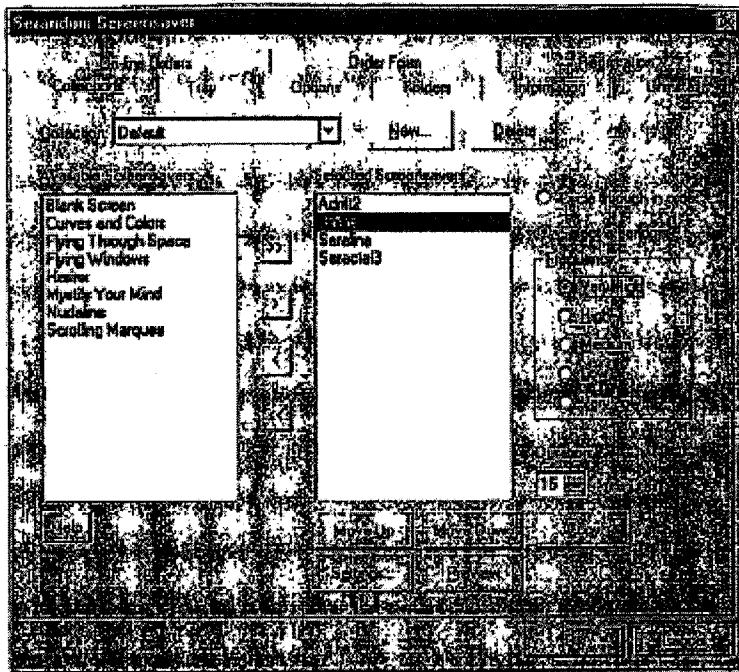
The application execution parameters “control some operational aspects of the associated application in the screen saver mode.” *Id.*

These teachings are nowhere in the cited references, and the rejection must be reversed for this reason alone. The references fail to disclose the claimed carousel. The Examiner purports to find the carousel at various places in the cited references. He finds the carousel in both the Serandom reference and (for the first time in the Examiner’s Answer) in the King reference,¹ but is wrong in both respects.

According to the Examiner, the Serandom reference discloses two versions of a carousel in two respects. At page 4 of the Answer, the Examiner asserts that “Serandom teaches on page 1 that screensavers can be organized via the screensaver program into different collections or carousels.” The Examiner is wrong. Page 1 of Serandom states very generally that Serandom “allows you to organize your screensavers into different collections.” How does this constitute a teaching of a “carousel”? Where is the teaching of a database? Where is the teaching that the database includes at least one application handle, and rules for selecting the at least one application handle? The teaching of “different collections” in the general introductory paragraph of Serandom is far insufficient to meet the claim.

The Examiner then asserts that the screen shot on page 2 of Serandom “shows how screensaver handles can be added to, remove from, or rearranged within a carousel.” This is in reference to the following screen shot:

¹ The Examiner arguably has raised a new ground of rejection under Rule 41.39(a)(2). Applicant requests that the appeal be maintained and that this reply brief be deemed responsive to this new ground, pursuant to the provisions of Rule 41.39(b)(2).



The Examiner is wrong again. The above figure illustrates only that screen savers can be organized by name into a group. There is no teaching of a database, of plural application handles, of rules, or of execution parameters. At page 5 of the Examiner's Answer, the Examiner asserts that "Serandom reference discloses in the screen shot on page 2 a plurality of rules for selecting application handles. The handles and corresponding rules are inherently stored in the storage medium." Where are these teachings in the above picture? Where does the examiner see the "rules" in the above? The Examiner is fabricating these details from imagination.

Later – and for the first time in the Examiner's Answer – the Examiner finds the "carousel" in Fig. 7 of the King reference:

As an example, a user can select one or more of a plurality of handles via the toolbar (carousel) of Fig. 7, wherein each of [602]-[610] is a handle for displaying a picture file....

This assertion, which is fundamentally inconsistent with the Examiner's earlier position, is just as wrong. Fig. 7 of King is as follows:

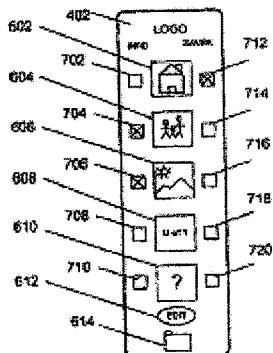


FIG. 7

This figure does not illustrate a carousel. As claimed, the carousel comprises a database. Fig. 7 depicts a user interface, not a database. The figure appears to depict a computer-generated toolbar that depicts a list of icons, each of which represents a picture that can be displayed on the user's screen. Via this toolbar, the user may select which pictures are displayed as a screensaver (via the Saver checkboxes) and whether information concerning the pictures is displayed (the INFO checkboxes). *See Fig. 5 and paragraph 40 of King.* Again, there is no teaching of a database, much less of the other parameters items specified by the claims. For instance, there are no rules for selecting an application handle. And in any case the Examiner's position is inconsistent with the idea that the carousel is the list of screen saver names in Serandom.

Hence, none of the references cited disclose the claimed "carousel." Beyond the foregoing, where does the Examiner purport to find the claimed "handles"? Again, the Examiner's position is confused and muddled. At page 4, the Examiner asserts that the Serandom screenshot shows how screensaver handles can be manipulated within a carousel. What are the "handles" in Fig. 2? Are they supposed to be the names of the various screensavers (and if so, what would constitute the rules)? Then, at page 7, the Examiner (asserts with respect to the King reference) that "each of [602]-[610] is a handle for displaying a picture file containing a plurality of pictures, each handle having associated parameters for execution...." Evidently, the Examiner is contending that the picture icons in the user interface toolbar of Fig. 7 are "handles." Later, though, the Examiner "respectfully contends that King teaches handles (picture files) selectable via a plurality of screensavers arranged in a carousel (see paragraph 40 in Fig. 7) wherein the

handles are stored in a database (see paragraphs 29 and 30). Thus, in this portion of the Examiner's answer, the Examiner contends that King's picture files are the handles.

It is difficult to begin to analyze the Examiner's Answer when it is based on this illogical and inconsistent reasoning. Are the icons of King supposed to relate somehow to the screensaver file names in Serandom? If, in King, the "handles" are supposed to be picture files stored in a database as opposed to the icons, then how could the user interface in Fig. 7 be deemed a "carousel"? Fig. 7 does not include the picture files. If the icons (or perhaps the checkboxes) of King are the handles, then where is the database, and where are the rules? How do the pictures, icons, or checkboxes of King relate to the screen saver names in Serandom? The Examiner's reasoning makes no sense at all.

Several claims are even further removed from the cited references. For instance, with respect to claim 11 where is the teaching of an additional application having a corresponding screensaver mode? None of the three cited references meet this limitation. The Examiner asserts with respect to this claim that "Serandom discloses in a screen shot on page 2 means for executing additional applications like Drempels in a screensaver mode. Here, the Examiner ignores his previous argument that the Serandom screenshot shows plural handles - now, according to the Examiner, the various file names constitute plural applications instead of handles. This cannot be a correct reading of the reference - the screensaver name shown in Drempels cannot be both handles and separate applications. In any case, the screensavers in Serandom are not taught as having plural modes.

With respect to claim 35, this claim specifies that the processor "is configured to add an application handle to the carousel in response to the user selection of a screensaver mode option presented by the application while in full application mode." Where are these teachings in the cited art? The Examiner, at page 15 of the Answer, purports to find these teachings in the Drempels reference. Drempels purports to teach that screensavers can be run in two modes ("full screen mode when invoked as a screensaver, and a desktop mode when you invoke it yourself.") This is not a teaching of "user selection of a screensaver mode option presented by the application while in

full application mode." Neither Drempels nor any other reference of record discloses or suggests this feature.

Similarly, claim 36 (which specifies one or more screensaver mode options selectable by user while operating the at least one application in a full application mode) and claim 37 (which specifies adding an application handle to the screensaver carousel in response to user selection to the screensaver mode option presented by the application while in full application mode) are separately patentable. These features likewise are not found in the cited art.

In summary, the Examiner's positions are incorrect, and must be reversed.

Finally, since the filing of this appeal, the Court of Appeals for the Federal Circuit has decided *In re Bilski*, ____ F.3d ____ (Fed. Cir. October 30, 2008) (en banc). *Bilski* does not affect the patentability, under 35 U.S.C. 101, of the pending method claims. Independent claim 24 specifies starting a screensaver program in a device that comprises a display screen, storage medium, and other physical elements. *Bilski* held that "a claim that purportedly lacks any 'physical steps' but is still tied to a machine or achieves an eligible transformation passes muster under § 101." *Bilski*, slip opinion at 23. In this case, the pending method claims should not be rejected under § 101, both because they are "tied to a machine" (as specified in the claims) and because they achieved an "eligible transformation."

The Board should reverse the Examiner and should allow the pending claims.

Respectfully submitted,

Dated: December 15, 2008

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